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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/067,368

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Kiyomi Sakamoto

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10/21/2005

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EXAMINER

LE, KHANH H

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/067,368

Applicant(s)

SAKAMOTO ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 5/10/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-10, 12 and 13 is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/9/02, 2/24/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. This Office Action is responsive to the correspondence filed on 5/10/05.
2. The amendments of claims 1, 9, 10, 12 and 13 have been entered. Claims 1-10, 12 and 13 are presented for prosecution. Claims 1, 9, 10, 12 and 13 are independent. The substitute specification, abstract and replacement Figures 1-27B have been accepted.

### **Responses to Arguments**

3. Applicant's arguments filed on have been fully considered but are moot in view of application of new prior art.

### ***Claim Rejections - 35 USC § 112***

- 4a. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 4b. **Claims 1, 4, 6-10, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

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As to claims 1, 4, 6-10, 12, it is unclear what the “bonus awarding side” refers to. Is it a person as a merchant? or is it a location such as a store? As used in claims 1, 7, 8-10, 12, it seems to be a store. As used in claims 4, and 6, it seems to be a person. Claims 4 and 6 have no proper antecedent basis if so interpreted. Appropriate clarification and /or correction is required. For prior art application, the phrase is interpreted as being a store in claims 1, 7, 8-10, 12 and a person in claims 4, and 6.

As to claim 1, “said server is operable...” is unclear. What does the server actually do since “operable” only means “capable of operating” and not actually operating and any computer or server is operable to do anything as long as it programmed properly so that any server in the prior art would read on that phrase describing the server in those terms. Appropriate correction is required.

“based on input data” as used in the phrase “said server is operable to perform data communication between the first and second data terminal devices for a user of the first data terminal device to initiate and configure the bonus attached file based on input data.” is unclear: who is inputting this data? the store merchant or the consumer/ user?

Further why does the server have to be operable to communicate between the first and second data terminal devices “for a user of the first data terminal device to ...configure the bonus” since only communication between the first data terminal device and the server would suffice to do this operation. Appropriate correction is required to clarify the implications of this limitation and thus to clarify its extent and scope.

Further, as to claim 4, it is unclear what “ a first data terminal device side” means in the phrase “to be inputted on (emphasis added) a first data terminal device side” . Is the “a first data terminal device side” here the same as the “first data terminal device” of claim 1?

(Note: “said item data creation part” in this claim seems to refer back to the “first data terminal device” of claim 1, so why is “a first data terminal device side” used here? )

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Further what does “inputted on (emphasis added) a device” mean? Does it mean “inputted from a device”?

Then again what does “the bonus awarding side” in the phrase “inputted on (emphasis added) the bonus awarding side” mean? Is it the same as the “first data terminal device” of claim 1. If yes, the same nomenclature should be used to avoid confusion. Appropriate correction is required.

As to claim 12, it is utterly incomprehensible. It is not clear from the claim language whether there are 2 terminals or not, on the bonus awarding side, with one being called an external data terminal. It seems the preamble refers to two terminals on the bonus awarding side and one terminal on the consumer side, yet it could also mean there is only one terminal on the bonus awarding side and one terminal on the consumer side. The phrase “said data terminal” used repeatedly is confusing because at least 3 terminals seem to be mentioned in the preamble and it’s unclear which terminal “said data terminal device” refers to. ( Example of unclear phrase: “said data terminal device comprising” ). It is not clear from the whole claim whether the internal bonus identifier is stored at the bonus awarding side or on the consumer side. Further in the preamble “and the data terminal device and for (emphasis added) a user...” needs to be clarified.

Further Applicants argue that claim 12 contains one or more elements of claim 1, yet the Examiner cannot determine the configuration of system claim 12 with any certainty and it does not seem similar to claim 1, thus adding to the confusion.

Appropriate correction is required.

As this claim suffers from improper grammar, lack of antecedent, and/or missing essential steps and/or is internally contradictory, the Examiner would have to engage in substantial speculation to figure out how the invention is practiced

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In *Re Steele*, 134 USPQ 292, applied to a 35 USC 112(2<sup>nd</sup>) situation, held that an art rejection should not be applied when there is substantial guesswork involved in determining the scope of the claim or substantial confusion as to the interpretation of the claims because such rejection would be based on unsupported speculative assumptions. Thus there will be no Application of prior art to claim 12.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over KERNAHAN US 20020128903 A1 \*\***

KERNAHAN discloses  
a system and a method to transmit an encrypted e-coupon to a personal digital assistant ("PDA"), for use. A consumer next displays the e- coupon on the PDA to a merchant and the merchant gives the appropriate discount to the consumer. The e-coupon can be displayed on the PDA with an e- coupon application. To ~~redeem~~ the e-

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coupon, a merchant may be required to enter a passphrase to verify the contents of the e-coupon. In another system, the server may link the e-coupon to a geographic location on an electronic map. The electronic map is displayed on the PDA by the e-coupon application. Whenever a geographic location linked to an encrypted coupon is displayed, the e-coupon application displays an icon of the e-coupon. Furthermore, the consumer can perform a coupon search in the map application to find the electronic coupon. In addition, advertising fees for the merchants can be based on the number of times a coupon is displayed, activated, and redeemed.

A consumer can simply read a coupon (or an advertisement) displayed by PDA 48, check the location with the built in map software, physically go to the location, show the displayed coupon in PDA 48 to a merchant at the location and have the merchant redeem the coupon. Therefore, an electronic coupon as described herein need not be handled physically (e.g. no cutting no purchasing a magazine/newspaper, no directions needed, no need to remember to bring the coupon). Instead, the coupon is handled automatically, and its use is as easy as turning on the PDA. See [0038].

Thus as to claims 1,2-4, 6, 9, 10, and 13 KERNAHAN discloses a system, method, computer program with

creation of bonus/coupons by advertisers using forms transmitted from a server to the advertisers' computer (claims 3-4) (see at least Figs. 13-14A and associated text);

, after creation by the merchant side, transmission or uploading of the coupon file to the server (claim 6) for storage on the server (see [0055] - [0057]),

with many data file details (items) disclosed (see at least Figs. 12-14A and associated text)

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customer side requesting a coupon or bonus file from the server, storage of the file on the customer's storage (on PDA, see at least Figs. 15 and associated text)

the customer sending the bonus identifier to the merchant side device, and the merchant verifying the coupon validity before allowing redemption (see at least 0010]; [0089] Figs. 5, 8, 11 and associated text).

KERNAHAN does not specifically disclose storage at the merchant or advertiser database of the relevant coupon/bonus identifier though it discloses coupon ID ( Figure 11) and comparison of the identifier sent by the customer device to the merchant device to the internal identifier, upon presentment for redemption. However it is obvious to one skilled in the art to implement the systems and method steps as claimed to effect the KERNAHAN's teachings of verification by the merchant of the encrypted coupons for redemption, see [0010]; [0036] Figs. 5, 8, 11 and associated text)

As to claim 5 regarding coupon file stored at the merchant database and transmitted from the merchant to the consumer device, KERNAHAN at Figure 2 discloses such.

As to claim 7, KERNAHAN discloses online purchase/auto application of e-coupons see [0007] therefore a center station for charging the customer is implied.

As to claim 8, KERNAHAN discloses store location and route guidance (see at least [0036], [0038]; Figs. 17 and associated text)



### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 20020010623 A1 to MCCOLLOM, discloses

A system and method publish, distribute and redeem coupons on a network system. The system and method utilize a merchant server and a commerce server. The merchant server provides the merchant the ability to transmit requests to create a coupon, and transmit coupon data regarding the coupon creation. The commerce server receives the requests to create a coupon, and receives the coupon creation data. The commerce server saves the coupon data to a coupon database, and provides access to the coupon to customers on the network. A merchant server further provides the merchant the ability to receive a request for purchasing an item, and a request for redeeming a coupon for that purchase from a consumer. The merchant server verifies the coupon is a valid coupon, and allows the coupon to be redeemed in the purchase of the item if the coupon is valid. The merchant server upon redemption of the coupon, updates a coupon database to record that the coupon has been redeemed by the customer.

U.S. Pat. No. 4,882,675 to Nichtberger, et al. and entitled PAPERLESS SYSTEM FOR DISTRIBUTING, REDEEMING AND CLEARING MERCHANDISE COUPONS discloses a method and system in which cents-off merchandise coupons are distributed and redeemed immediately and electronically. An electronic display of coupons valid for use in a particular store is presented to customers in that store. When a customer makes a selection of coupons from the display, the selection is recorded. The customer is subsequently identified at a store checkout station as the one who made the selection. In a preferred embodiment, the identification is made by scanning a special card adapted for use with the system. The items purchased in the store by the customer are recorded, and any matches between the coupons selected and the items purchased are determined

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electronically. The customer is immediately credited in accordance with the terms of the matched coupons. Redeemed coupons are periodically cleared electronically.

**Meyer et al, US 6915271** discloses online purchase and redemption of coupons ,coupons ID's , storage on user databases, good history of other patents...

O'Hagan, Timothy ,US 20020178091 A1 connection of the customer can connect to the merchant's host computer 12 through the Internet, download of the coupon file, etc... When entering the store, the customer will pick up a cart 84 which has a customer information terminal (CIT) mounted thereto after logon to the CIT 14, the host computer 12 will send the CIT information relating to the particular customer. Such information will include the coupon file. FIG. 39. [0167] [0173].

Postrel, US 2004/0220854, discloses destination specific coupons for travelers.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

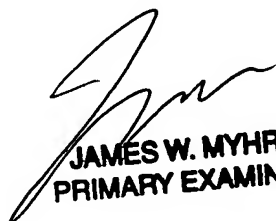
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 12, 2005

KHL. *KHL*

  
**JAMES W. MYHRE**  
**PRIMARY EXAMINER**